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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/823,103

03/30/2001

Vassil Iordanov

2028068-0021

8391

22469

7590

09/06/2006

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EXAMINER

JONES, HUGH M

ART UNIT

PAPER NUMBER

2128

DATE MAILED: 09/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/823,103

Applicant(s)

IORDANOV ET AL.

Examiner

Hugh Jones

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-29 of U. S. Application 09/823,103, filed 03/30/2001 are presented for examination. A requirement for information under 1.105 is presented at the end of this office action.

Declaration

2. The oath or declaration is defective. A new declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

3. The oath or declaration is defective for reasons presented in the response to Applicant's arguments, following the rejections. Clarification and/or correction is required.

4. As stated in the final rejection, the inventor has not specified any particular sections of the technical report. The rejection stated "Zachary et al. disclose CGF-COGNET, including all claimed limitations. See page 4; section 2.1; figure 2-3; sections 2.1.3.1, 2.1.3.2, pp. 18; 20; 22; 24-26; 30; 47; 56. Applicant's specification indicates that CGF-COGNET is also being disclosed. See pg. 9 (last three lines); pg. 16, lines 21-23pp. 22-26; pg. 28, lines 10-12; pg. 33, lines 16-17; pp. 35-42; pp. 48-51; pp. 54-55. Note especially, pg. 61, lines 17-18; pp. 73-78; pg. 81; pp. 85-88." Therefore, it is interpreted that the inventor is referring to those sections.

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Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

6. Claims 1-29 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by Zachary et al. (item “BM” in the IDS of 8/24/2001).

7. Zachary et al. disclose CGF-COGNET, including all claimed limitations. See page 4; section 2.1; figure 2-3; sections 2.1.3.1, 2.1.3.2, pp. 18; 20; 22; 24-26; 30; 47; 56. Applicant’s specification indicates that CGF-COGNET is also being disclosed. See pg. 9 (last three lines); pg. 16, lines 21-23pp. 22-26; pg. 28, lines 10-12; pg. 33, lines 16-17; pp. 35-42; pp. 48-51; pp. 54-55. Note especially, pg. 61, lines 17-18; pp. 73-78; pg. 81; pp. 85-88.

Response to Arguments

8. Applicant’s arguments filed 6/13/2005 have been carefully reviewed, but are not persuasive.

9. The 102 rejection is maintained because the invention the invention was known or used by *others* (different inventive entity) in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent. Applicants have made no arguments on the patentability over the prior art.

10. The 1.132 declaration has been carefully considered but is not persuasive.

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11. Full faith and credit is provided to Applicants regarding any seemingly inaccurate statements pertaining to the first declaration.

12. At the onset, it is noted that the serial number, namely 09/788,218 which is listed on the declaration, does not correspond to the instant application.

13. It is also noted that Applicants refer to Technical Report 000709.00001-05 and state on page 5 of the response of 7/31/2006 that it has been included in an IDS. No such paper has been entered. Furthermore, neither the transmittal form nor the request for RCE indicate that an IDS has been sent. Therefore, any reference to or arguments pertaining the Report are not considered and only paragraphs 1-4, 7-8 have been considered.

14. The declaration and accompanying remarks (Applicant's response of 7/31/2006) create more ambiguity. Applicants refer to In re DeBaun in the remarks and the statement "An uncontradicted, 'unequivocal statement' from the Applicant regarding the subject matter ... will be accepted as establishing inventorship."

15. The statement in the declaration is uncontradicted; however, it is equivocal and ambiguous. The definition of unequivocal is (Merriam Webster):

1 : leaving no doubt : **CLEAR, UNAMBIGUOUS**

2 : **UNQUESTIONABLE**

16. Paragraphs 3-4 of the declaration are not an unequivocal statement and create ambiguity:

- par. 3 states, "and the list of authors is not intended to be a list of inventors."

The relevance of this statement is unclear. The reference is non-patent

literature and thus at the time of publication, there is no reason to believe that

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an issue of inventorship would arise. Regardless, Applicants have made no statement regarding the role of the other Applicants such as, for example, whether or not they worked under the direction of the inventor.

- Par. 4: Applicant states that "I am the sole creator of certain subject matter ... that has been claimed." Applicant further states that the claims contain 'certain subject matter', but that the "certain subject matter" does not constitute 'any entire claim'. It is noted that it is unclear whether the "certain subject matter" disclosed in the report and "certain subject matter" contained in the claims are one and the same. In any case, the meaning of "certain subject matter" is unknown. For example, it is noted that a 102 anticipatory rejection was applied. So, there appears to be a question of whether the portions of the claims not covered by the "certain subject matter" would be attributed to other of the authors. Furthermore, specific sections of the Report were relied upon for the 102 rejection. In the final rejection of 7/27/2005, the following was stated:

4. The inventor did not specify any particular sections of the technical report. The rejection stated "Zachary et al. disclose CGF-COGNET, including all claimed limitations. See page 4; section 2.1; figure 2-3; sections 2.1.3.1, 2.1.3.2, pp. 18; 20; 22; 24-26; 30; 47; 56. Applicant's specification indicates that CGF-COGNET is also being disclosed. See pg. 9 (last three lines); pg. 16, lines 21-23pp. 22-26; pg. 28, lines 10-12; pg. 33, lines 16-17; pp. 35-42; pp. 48-51; pp. 54-55. Note especially, pg. 61, lines 17-18; pp. 73-78; pg. 81; pp. 85-88." Therefore, it is interpreted that the inventor is referring to those sections.

17. Applicants have been silent in response. Thus, there is ambiguity regarding what portions of the reference are attributable to Applicants.

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18. Consideration of *In re DeBaun* yields the following:

"[T]he proper subject of inquiry was * * * what the evidence showed as who invented the subject matter disclosed by [the reference] which was relied on to support the rejection. [In re Land, 54 CCPA at 825, 368 F.2d at 879-80, 151 USPQ at 633 n.11 (emphasis in original).]"

"As in *Katz*, supra, the question of whether appellant is the sole inventor was properly raised by the PTO, and it was incumbent on appellant to provide satisfactory evidence, in light of the total circumstances of the case, that the reference reflected his own work. In re *Facius*, supra; In re *Land*, supra."

19. See also *Riverwood International Corp. v. R.A. Jones & Co.* (2003):

"What is significant is not merely the differences in the listed inventors, but whether the portions of the reference relied on as prior art, and the subject matter of the claims in question, represent the work of a common inventive entity. See *In re DeBaun*, 687 F.2d 459, 462, 214 USPQ 933, 935 (CCPA 1982). What is significant is not merely the differences in the listed inventors, but whether the portions of the reference relied on as prior art, and the subject matter of the claims in question, represent the work of a common inventive entity. See *In re DeBaun*, 687 F.2d 459, 462, 214 USPQ 933, 935 (CCPA 1982)." See *Riverwood International Corp. v. R.A. Jones & Co.*, 66 USPQ2d 1331 (CA FC 2003).

20. The question of what was invented by who has not been answered.

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21. Paragraph 7 also creates ambiguity because it states that the current declaration “clarifies the scope of the previously made declaration.” Respectfully, the meaning of this statement is not understood.

22. Applicant’s remarks (page 2, last paragraph - 7/31/2006) also create confusion because they attempt to import meaning to the declaration. It is also noted that the statements on the top of the next page includes (emphasis added, “... certain subject matter *that may be* contained in the claims.” This is an equivocal statement.

23. Applicant’s remarks (page 3, first full paragraph - 7/31/2006) are noted but are not persuasive. Applicants have cited no case law supporting such a position.

24. Applicant’s unequivocal statement regarding inventorship of the application and any government interests are persuasive.

25. This Office action has an attached requirement for information under 37 CFR 1.105. A complete reply to this Office action must include a complete reply to the attached requirement for information. The time period for reply to the attached requirement coincides with the time period for reply to this Office action.

Requirement for Information under 37 CFR 1.105

26. For the reasons discussed above and further because of the apparent confusion arising from the two declarations, a 1.105 requirement for information is being made at this time.

27. There is a great deal of confusion regarding the 1.132 declarations and their use in an attempt to defeat the 102 rejections.

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28. Thus, information regarding what may be attributed to the inventors of the application is critical to proper and timely examination of the instant application.

29. Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.

30. Please provide the document that is referred to in paragraphs 5-6 of the declaration of 7/31/2006.

30. In response to this requirement, please provide answers to each of the following interrogatories eliciting factual information regarding the two documents in question (Zachary et al. (item "BM" in the IDS of 8/24/2001, and the document referred to in paragraphs 5-6 of the declaration):

- **please indicate which portions of the two documents (Zachary et al. (item "BM" in the IDS of 8/24/2001, and the document referred to in paragraphs 5-6 of the declaration) are attributed to Zachary.**
- **please indicate which limitations in the claims in question are disclosed by said portions attributed to Zachary in said documents.**
- **please indicate which limitations in the claims in question are disclosed by portions *not* attributed to Zachary in said documents.**

31. The fee and certification requirements of 37 CFR 1.97 are waived for those documents submitted in reply to this requirement. This waiver extends only to those documents within the scope of this requirement under 37 CFR

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1.105 that are included in the applicant's first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement and any information disclosures beyond the scope of this requirement under 37 CFR 1.105 are subject to the fee and certification requirements of 37 CFR 1.97.

32. The applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 CFR 1.56. Where the applicant does not have or cannot readily obtain an item of required information, a statement that the item is unknown or cannot be readily obtained may be accepted as a complete reply to the requirement for that item.

33. This requirement is an attachment of the enclosed Office action. A complete reply to the enclosed Office action must include a complete reply to this requirement. The time period for reply to this requirement coincides with the time period for reply to the enclosed Office action.

34. Any inquiry concerning this communication or earlier communications from the examiner should be:

directed to: Dr. Hugh Jones telephone number (571) 272-3781,

Monday-Thursday 0830 to 0700 ET,

or

the examiner's supervisor, Kamini Shah, telephone number (571) 272-2279.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, telephone number (703) 305-3900.

mailed to:

Commissioner of Patents and Trademarks

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Washington, D.C. 20231

or faxed to:

(703) 308-9051 (for formal communications intended for entry)

or (703) 308-1396 (for informal or draft communications, please label *PROPOSED* or *DRAFT*).

Dr. Hugh Jones

Primary Patent Examiner

August 31, 2006

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